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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,422	12/17/2001	Oscar A. Zuniga	10016478-1	3354

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EXAMINER

QUELER, ADAM M

ART UNIT PAPER NUMBER

2178

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,422

Applicant(s)

ZUNIGA ET AL.

Examiner

Adam M. Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment received 07/15/2005.
2. Claims 1-27 are pending in the case. Claims 1-7 are withdrawn. Claims 8 and 14 are pending independent claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/15/2005 has been entered.

Election/Restrictions

4. Claims 1-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 03/03/2005.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 8-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 8 and 14 recite a "... device configured for sending and receiving electronic documents **with** a plurality of different types of ... devices." There appears to me a minor grammatical with

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this phrase. It appears Applicant intended “to”, “from”, or “between” possibly instead “with” as used in the claim. For examining purposes only the former meaning will be used.

Claim Rejections - 35 USC § 102

7. Claims 8-22, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Quentin et al. (US005208745A, patented 6/4/1990).

Regarding independent claim(s) 8, Quentin teaches receiving a multimedia presentation (col. 4, 11. 48-54). Quentin teaches separating the media (col. 5, 11. 62-65). Quentin teaches a multi-function device (Fig. 1). Quentin teaches the device is configured for sending and receiving documents to or from a plurality of devices (col. 23, line 60 - col. 24 line 7).

Regarding dependent claim(s) 9, Quentin teaches displaying media (col. 12, 11. 41-43).

Regarding dependent claim(s) 10, Quentin teaches printing media (col. 5, line 52).

Regarding dependent claim(s) 11, Quentin teaches generating sound from media (col. 5, line 52).

Regarding dependent claim(s) 12, Quentin teaches the audio is used to help a user with the first media. This is determined to be an annotation.

Regarding dependent claim(s) 13, Quentin teaches synchronizing the media (col. 4, line 67 - col. 5, line 6).

Regarding independent claim(s) 14, Quentin teaches transducers for formatting the two media (col. 4, 11. 41-47). Quentin teaches receiving a multimedia presentation (col. 4, 11. 48-54). Quentin teaches separating the media (col. 5, 11. 62-65). Quentin teaches the media are for network delivery (col. 23, line 50 - col. 24, line 24). Quentin teaches a multi-function device

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(Fig. 1). Quentin teaches the device is configured for sending and receiving documents to or from a plurality of devices (col. 23, line 60 col. 24 line 7).

Regarding dependent claim(s) 15, Quentin teaches an interface (col. 2, ll. 24-25).

Regarding dependent claim(s) 16, Quentin teaches sending to a network destination (col. 23, line 50 - col. 24, line 24).

Regarding dependent claim(s) 17, Quentin teaches receiving at network destination (col. 23, line 50 - col. 24, line 24).

Regarding dependent claim(s) 18, Quentin teaches synchronizing the media (col. 4, line 67 col. 5, line 6).

Regarding dependent claim(s) 19, Quentin teaches an audio transducer (col. 4, ll. 41-43).

Regarding dependent claim(s) 20, Quentin teaches a screen for display, or imaging transducer (col. 4, ll. 15-16).

Regarding independent claim(s) 21, Quentin teaches a multi-function device (Fig. 1). Quentin teaches separating the media (col. 5, ll. 62-65), for each output device, thereby separating the audio from the video. Quentin teaches outputting the visual component (col. 19, ll. 11-14), as well as the audio (col. 19, ll. 50-60). Quentin discloses a plurality of multimedia transmission devices (col. 24, ll. 4-6).

Regarding dependent claim(s) 22, Quentin teaches a networked computer (col. 23, line 50 - col. 24, line 24).

Regarding dependent claim(s) 26, Quentin teaches outputting based on a tag (col. 6, ll. 1-12). Quentin teaches that the visual and audio media are synchronized and outputted (col. 5, ll. 4-6 and col. 6, ll. 20-24).

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Regarding dependent claim(s) 27, Quentin teaches outputting a message (col. 5, ll. 50-54).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quentin.**

Regarding dependent claim(s) 23, Quentin discloses a satellite system used for communication (col. 23, line 50 - col. 24, line 24). Quentin does not teach an Internet site. Official Notice is taken that the time of the current invention an Internet website was a well-known, common and desirable way to communicate with remote device. (As per MPEP 2144.03(C) this is now taken to be Admitted Prior Art because Applicant has not traversed the examiner's assertion of Official Notice). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the satellite system of Quentin with a well-known website, as the Internet was known to be cheaper than a satellite communication network, and this would not change the essential function of Quentin.

Regarding dependent claim(s) 24, it would have been obvious to substitute the Internet for the communication means of Quentin as described in claim 23 above. Given that obviousness any communication from a website would inherently be a computer readable data file.

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Regarding dependent claim(s) 25, it would be have been obvious to substitute the Internet for the communication means of Quentin as described in claim 23 above. Given that obviousness any communication from the website would inherently be a computer readable data file.

Response to Arguments

10. Applicant's arguments filed 07/15/2005 have been fully considered but they are not persuasive.

Regarding Applicant's remarks on Claims 8 and 14 (additionally addressing claims 9-13 and 15-20):

Applicant alleges that the new definition of “multi-function device,” overcomes the rejection. However, Quentin teaches the device is configured for sending and receiving documents to or from a plurality of devices (col. 23, line 60 col. 24 line 7).

Regarding Applicant's remarks on Claim 21 (additionally addressing claims 22-27):

Applicant alleges that Quentin does not disclose receiving presentations form a plurality of electronic transmission devices. However Quentin does disclose a plurality of multimedia transmission devices (col. 24, ll. 4-6).

Applicant alleges that Quentin does not teach separating text and audio, but rather each entry. However, Quentin specifically discloses that information for each module is separated each output module, in other words, the display, the speaker, etc. Therefore, the audio annotation and visual component are separated (col. 5, ll. 62-65).

Regarding Applicant's remarks on Claim 26:

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Applicant alleges that the tags do not enable synchronously outputting the visual component and corresponding audio. However, Quentin teaches that the text is spoken at the same time the record is displayed (col. 6, ll. 20-24).

Regarding Applicant's remarks on Claims 23 and 24:

Applicant alleges that the Examiner has not provided motivation for modifying Quentin "to operate in 'tight quarters' to access an Internet site." The only modification the Office has suggested is replacing the satellite communication with the Internet. The Office has provided motivation for this change. Applicant has not claimed operating in "tight quarters" and regardless Quentin suggests such an optional use, as Applicant has pointed out.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
8/4/2005